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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
08/776,786	05/01/1997	MARTINE BARKATS	ST94065-US	2477

7590

06/24/2003

FINNEGAN, HENDERSON, FARABOW, GARRETT AND DUNNER,
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1300 I STREET, N.W.
WASHINGTON, DC 20005-3315

EXAMINER

PRIEBE, SCOTT DAVID

ART UNIT	PAPER NUMBER
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1632

44

DATE MAILED: 06/24/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Advisory Action

Application No.
08/776,786

Applicant(s)
Barkats et al.

Examiner
Scott D. Priebe, Ph.D.

Art Unit
1632

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED Jun 2, 2003 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid the abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

THE PERIOD FOR REPLY [check only a) or b)]

- a) ☒ The period for reply expires 4 months from the mailing date of the final rejection.
- b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection. ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☐ A Notice of Appeal was filed on _____. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☐ The proposed amendment(s) will not be entered because:
- (a) ☐ they raise new issues that would require further consideration and/or search (see NOTE below);
- (b) ☐ they raise the issue of new matter (see NOTE below);
- (c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
- (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____

3. ☐ Applicant's reply has overcome the following rejection(s): _____

4. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).

5. ☒ The a) ☐ affidavit, b) ☐ exhibit, or c) ☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because:
see next page

6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.

7. ☒ For purposes of Appeal, the proposed amendment(s) a) ☐ will not be entered or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: none

Claim(s) objected to: none

Claim(s) rejected: 27, 34-36, 38, 40, 41, and 48-50

Claim(s) withdrawn from consideration: none

8. ☐ The proposed drawing correction filed on _____ is a) ☐ approved or b) ☐ disapproved by the Examiner.

9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____

10. ☐ Other: _____

SCOTT D. PRIEBE, PH.D.
PRIMARY EXAMINER
ART UNIT 1632

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Advisory Action

Item 5: With respect to section II.A., Applicant argues that because French does not explicitly direct one of skill in the art to use the human glutathione coding sequence as compared to a bovine glutathione coding sequence, there is no motivation to choose the human sequence. However, French does not teach that one should use the bovine sequence in particular, as opposed to a human sequence. French merely provides a source for a glutathione peroxidase sequence, which is the bovine sequence. French leaves it to the skilled artisan to choose the specific glutathione peroxidase. The invention of French requires coding sequence for a glutathione peroxidase, Mullenbach teaches one such sequence. The selection of a known material suitable for its intended use supports an obviousness rejection, see MPEP 2144.07.

With respect to Applicants second point, the statement excerpted from the previous Office action contains an error. It should have stated: "applicant has not challenged that one of ordinary skill in the art was aware of the potential for immune response ...", i.e. "not" was inadvertently included before "aware".

With respect to section II.B., Applicant first appears to argue that because Ohya does not teach the use of an adenoviral vector and because McClelland does not teach to produce glutathione peroxidase from an adenoviral vector, that the references cannot properly be combined to show obviousness. However, these reasons only show why either reference alone cannot be used to show anticipation. Applicant's following argument appears directed to whether one of skill on the art would have had a reasonable expectation of the success of replacing the

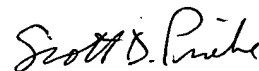
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plasmid vector of Ohya with the adenoviral vector of McClelland for the purpose of producing human glutathione peroxidase. However, Ohya shows that glutathione peroxidase can be produced recombinantly, and McClelland shows that adenoviral vectors can be used to produce proteins recombinantly. Applicant fails to indicate why one of ordinary skill in the art would have any doubt of the success in using an adenoviral vector to produce human glutathione peroxidase. In this combination, the adenoviral vector of McClelland would have been used for a purpose, producing a recombinant protein, for which it was known to be suitable, in place of a different type of vector, the plasmid vector used by Ohya, also known to be useful for producing recombinant protein. Again, see MPEP 2144.07.

Certain papers related to this application may be submitted to Art Unit 1632 by facsimile transmission. The FAX numbers are (703) 308-4242 or (703) 305-3014 for any type of communication. In addition, FAX numbers for a computer server system using RightFAX are also available for communications before final rejection, (703) 872-9306, and for communications after final rejection, (703) 872-9307, which will generate a return receipt. The faxing of such papers must conform with the notices published in the Official Gazette, 1156 OG 61 (November 16, 1993) and 1157 OG 94 (December 28, 1993) (see 37 CFR 1.6(d)). NOTE: If applicant *does* submit a paper by FAX, the original copy should be retained by applicant or applicant's representative. NO DUPLICATE COPIES SHOULD BE SUBMITTED, so as to avoid the processing of duplicate papers in the Office.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Scott D. Priebe whose telephone number is (703) 308-7310. The examiner can normally be reached on Monday through Friday from 8 AM to 4 PM. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Deborah Reynolds, can be reached on (703) 305-4051.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-0196.



SCOTT D. PRIEBE, PH.D
PRIMARY EXAMINER